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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,477	01/11/2000	GEORGE G. GELFER	P99.2547	5685

7590 12/18/2006

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6600 Sears Tower
Chicago, IL 60606

EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/481,477	Applicant(s) GELFER, GEORGE G.	
	Examiner Naresh Vig	Art Unit 3629	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

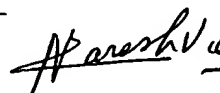
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 27-40 and 42.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-7 and 9-26.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____



Naresh Vig
Examiner
Art Unit: 3629

In response to applicant's argument that rejection of claim 5 under 35 USC 101 be removed because resetting of count at beginning of each print job will destroy the invention. In view of applicant's recitation of pending claims 1, 3 and 5, applicant claimed "an item count" is the volume of ink consumed for each of a imprint, and, "a predetermined counter" is the volume of ink, rejection of claim 5 under 35 USC 101 is removed.

In response to applicant's argument that there is no motivation to combine Saito reference with Barnes et al reference in order to arrive at the claimed invention.

However, Saito reference teaches that "This facsimile is registered beforehand" [Saito, page 7] i.e. its devices are registered with the supplier. In addition, Saito invention teaches use for registration number to determine what supplies need to be supplied for ordering Saito device. Also, Saito teaches to check whether the device is Illegibel Device [Fig. 1, label 45 and disclosure associated with Fig. 1]. Barnes et al. teaches that checking authority of an ordering entity may be checked prior fulfilling the order.

In response to applicant's argument that cited reference Barnes et al system defeats the possibility of being conducted completely automatically or completely electronically, because a manual selection by the customer must be made alter the customer is presented with a list that is determined dependent on the customer's access level.

However, applicant is seperating the cited references to make their argument. Applicant has not positively claimed there is no human intervention because the ordering process is fully automated because the message is sent to a data center. It is known to one of ordinary skill in the art at the time of invention that data center can comprise computer systems and personnel. Applicant has not positively claimed order is placed by a device to a fulfillment server as being argued by the applicant.

In response to applicant's argument that it is impossible for cited reference Barnes et al for the customer ever to place an order that cannot be filled. The customer in the Barnes et al system can only place an order from the approved list.

However, as argued by applicant that their invention is completely electronic, it is inherent that in applicant's claimed and argued invention it is inherent that devices will order supplies only from the list programmed in the device. Applicant has not positively claimed that the claimed method and device will generate an order of another item when the monitored consumable item reaches a threshold. Saito positively teaches its device and conumables items for the device are registered with the supplier.

In the interview conducted 15 November 2006, applicant's representative was informed that claim 21 may be allowable if claim 21 with all the intervening claim included are written in independent form, with further clarifying what action is taken by the ordering device upon the receipf of the confirmation message.

As argued by the applicant that the claimed invention is fully automated without the human intervention, claimed invention of claim 24 and 25 teach otherwise.